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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,018	11/21/2001	Hijin Sato	15689.93	9490
22913	7590	04/23/2004		
WORKMAN NYDEGGER (F/K/A WORKMAN NYDEGGER & SEELEY) 60 EAST SOUTH TEMPLE 1000 EAGLE GATE TOWER SALT LAKE CITY, UT 84111				
			EXAMINER QUINONES, ISMAEL C	
			ART UNIT 2686	PAPER NUMBER

DATE MAILED: 04/23/2004

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/989,018

Applicant(s)

SATO ET AL.

Examiner

Ismael Quiñones

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4, 8 & 10.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. Information disclosure statements (IDS) submitted on November 21, 2001 have being considered by the examiner and made of record in the application file.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1-2, 4, 7-9, 11, and 14** are rejected under 35 U.S.C. 102(e) as being anticipated by Takahashi et al. (U.S Pat. No. 6,070,081).

Regarding **claim 1**, Takahashi et al. disclose a base station for use in a multi-network connection communication system (A radio base station that enables communications to a private and a public system/network; *col. 4, lines 41-46 and lines*

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62-65; *col. 5, lines 26-32; col. 8, lines 60-65; See Figs. 10, 16 and 17*) comprising means for making a decision as to whether a terminal is to be connected to a carrier network or a private network (Wherein if a mobile radio telephone or terminal located that does not belong to a private system, furthermore located within the area of said system, is enabled a public connection through the system, otherwise if the terminal belongs or is registered to the private system requests connection, the system grants a connection in the system to the terminal; *col. 7, lines 50-55; col. 8, lines 17-39; See Fig. 10*); and means for connecting said terminal to said carrier network or said private network in accordance with the decision result (Wherein the base station comprises means for connecting said terminal such as private and public protocol processing sections; *col. 10, line 65 thru col. 11, line 17; col. 12, lines 2-19*).

Regarding **claim 2**, and as applied to claim 1, Takahashi et al. disclose the aforementioned base station, wherein said base station further comprises means for assigning resources to the communication of said terminal in accordance with predetermined setting information (Wherein the base station provides resources such as group of frequencies, each group of frequencies pertaining to either private or public resources controlled, such resources assigned according to the type of connection request made by the terminal; *col. 3, lines 52-63; See Fig. 7*).

Regarding **claim 4**, and as applied to claim 1, Takahashi et al. disclose the aforementioned base station, wherein charges for said carrier network levied on an owner of said private network are discounted in accordance with predetermined setting information (Wherein a radio base station pertaining to the private system bills the cost of

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communications to a mobile radio telephone or terminal in accordance with a predetermined setting information that indicates if the terminal is registered under the private system; *col. 8, line 60-65; col. 10, lines 25-42; Fig. 16, item 81; Fig. 17, item 82*).

Regarding **claim 7**, and as applied to claim 1, Takahashi et al. disclose the aforementioned base station, wherein said base station is owned by an owner of said private network (A radio base station that is located within the vicinity of the private system; *col. 1, lines 31-37; Fig. 1, item 40; Figs. 8, 16, and 17; item 4*).

Regarding **claim 8**, Takahashi et al. disclose a connecting method for use in a base station for use in a multi-network connection communication system (A radio base station that enables communications to a private and a public system/network; *col. 4, lines 41-46 and lines 62-65; col. 5, lines 26-32; col. 8, lines 60-65; See Figs. 10, 16 and 17*) comprising the steps of: making a decision as to whether the a terminal is to be connected to a carrier network or a private network (Wherein if a mobile radio telephone or terminal located that does not belong to a private system, furthermore located within the area of said system, is enabled a public connection through the system, otherwise if the terminal belongs or is registered to the private system requests connection, the system grants a connection in the system to the terminal; *col. 7, lines 50-55; col. 8, lines 17-39; See Fig. 10*); and connecting said terminal to said carrier network or said private network in accordance with the decision result (Wherein the base station comprises means for connecting said terminal such as private and public protocol processing sections; *col. 10, line 65 thru col. 11, line 17; col. 12, lines 2-19*).

Regarding **claim 9**, and as applied to claim 8, Takahashi et al. discloses the aforementioned connecting method, wherein said connecting method further comprises the step of assigning resources to the communication of said terminal in accordance with predetermined setting information (Wherein the base station provides resources such as group of frequencies, each group of frequencies pertaining to either private or public resources controlled, such resources assigned according to the type of connection request made by the terminal; *col. 3, lines 52-63; See Fig. 7*).

Regarding **claim 11**, and as applied to claim 8, Takahashi et al. disclose the aforementioned connecting, wherein charges for said carrier network levied on an owner of said private network are discounted in accordance with predetermined setting information (Wherein a radio base station pertaining to the private system bills the cost of communications to a mobile radio telephone or terminal in accordance with a predetermined setting information that indicates if the terminal is registered under the private system; *col. 8, line 60-65; col. 10, lines 25-42; Fig. 16, item 81; Fig. 17, item 82*).

Regarding **claim 14**, and as applied to claim 8, Takahashi et al. disclose the aforementioned connecting method, wherein said base station is owned by an owner of said private network (A radio base station that is located within the vicinity of the private system; *col. 1, lines 31-37; Fig. 1, item 40; Figs. 8, 16, and 17; item 4*).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. **Claims 3, 5, 10, and 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi et al. (U.S Pat. No. 6,070,081) in view of Gordon (U.S Pat. No. 4,993,014).

Regarding **claim 3**, and as applied to claim 2, Takahashi et al. disclose the aforementioned base station, wherein said predetermined setting information is a maximum providing ratio for users of said carrier network (A maximum providing ratio such as ratio of connection set to predetermined rate to allow connectivity; *col. 5, lines 33-47; col. 9, line 65 thru col. 10, line 24*) or priority (Priority for connectivity to those users who belong to the private system; *col. 4, lines 14-20*). Takahashi et al. fail to clearly specify wherein said predetermined setting information is a maximum providing ratio for users of said carrier network and priority.

In the same field of endeavor, Gordon discloses a method for providing telecommunication services to private customer networks, wherein the method comprises algorithms for allowing priority when overloading conditions develop, said overload

conditions depending on a predetermined setting information (*col. 5, line 65 thru col. 6, line 1; col. 6, lines 53-57 and 61-64*).

Therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to have Takahashi base station comprising means for assigning resources to the a communication terminal according to a priority set by overloading or capability information as taught by Gordon, for the purpose of upholding a quality of service for those pre-defined users of a particular network, when requesting resources or communications within the network.

Regarding **claim 5**, and as applied to claim 4, Takashi et al. disclose the aforementioned base station, wherein said predetermined setting information is a maximum providing ratio for users of said carrier network (A maximum providing ratio such as ratio of connection set to predetermined rate to allow connectivity; *col. 5, lines 33-47; col. 9, line 65 thru col. 10, line 24*) or priority (Priority for connectivity to those users who belong to the private system; *col. 4, lines 14-20*). Takahashi et al. fail to clearly specify wherein said predetermined setting information is a maximum providing ratio for users of said carrier network and priority.

In the same field of endeavor, Gordon discloses a method for providing telecommunication services to private customer networks, wherein the method comprises algorithms for allowing priority when overloading conditions develop, said overload conditions depending on a predetermined setting information (*col. 5, line 65 thru col. 6, line 1; col. 6, lines 53-57 and 61-64*).

Therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to have Takahashi base station comprising means for assigning resources to the a communication terminal according to a priority set by overloading or capability information as taught by Gordon, for the purpose of upholding a quality of service for those pre-defined users of a particular network, when requesting resources or communications within the network.

Regarding **claim 10**, and as applied to claim 9, Takahashi et al. disclose the aforementioned connection method, wherein said predetermined setting information is a maximum providing ratio for users of said carrier network (A maximum providing ratio such as ratio of connection set to predetermined rate to allow connectivity; *col. 5, lines 33-47; col. 9, line 65 thru col. 10, line 24*) or priority (Priority for connectivity to those users who belong to the private system; *col. 4, lines 14-20*). Takahashi et al. fail to clearly specify wherein said predetermined setting information is a maximum providing ratio for users of said carrier network and priority.

In the same field of endeavor, Gordon discloses a method for providing telecommunication services to private customer networks, wherein the method comprises algorithms for allowing priority when overloading conditions develop, said overload conditions depending on a predetermined setting information (*col. 5, line 65 thru col. 6, line 1; col. 6, lines 53-57 and 61-64*).

Therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to have Takahashi base station comprising means for assigning resources to the a communication terminal according to a priority set by

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overloading or capability information as taught by Gordon, for the purpose of upholding a quality of service for those pre-defined users of a particular network, when requesting resources or communications within the network.

Regarding **claim 12**, and as applied to claim 11, Takahashi et al. disclose the aforementioned connection method, wherein said predetermined setting information is a maximum providing ratio for users of said carrier network (A maximum providing ratio such as ratio of connection set to predetermined rate to allow connectivity; *col. 5, lines 33-47; col. 9, line 65 thru col. 10, line 24*) or priority (Priority for connectivity to those users who belong to the private system; *col. 4, lines 14-20*). Takahashi et al. fail to clearly specify wherein said predetermined setting information is a maximum providing ratio for users of said carrier network and priority.

In the same field of endeavor, Gordon discloses a method for providing telecommunication services to private customer networks, wherein the method comprises algorithms for allowing priority when overloading conditions develop, said overload conditions depending on a predetermined setting information (*col. 5, line 65 thru col. 6, line 1; col. 6, lines 53-57 and 61-64*).

Therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to have Takahashi base station comprising means for assigning resources to the a communication terminal according to a priority set by overloading or capability information as taught by Gordon, for the purpose of upholding a quality of service for those pre-defined users of a particular network, when requesting resources or communications within the network.

8. **Claims 6 and 13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi et al. (U.S Pat. No. 6,070,081) in view of Acampora (U.S Pat. No. 6,314,163).

Regarding **claim 6**, and as applied to claim 7, Takashi et al. disclose the aforementioned base station. Takahashi et al. fail to clearly specify, wherein said base station is owned by a carrier that provides said carrier network.

In the same field of endeavor, Acampora discloses a base station that is owned by a public or network or service provider, furthermore leasing said base station on a residential property (*col. 15, lines 18-28*).

Therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to have Takahashi et al. base station to being owned by a carrier network as taught by Acampora, for the purpose of allowing system operability in remote areas wherein the system coverage does not reach residents of such areas due to geographical isolation to the system.

Regarding **claim 13**, and as applied to claim 8, Takahashi et al disclose the aforementioned connecting method for use in a base station. Takahashi fail to clearly specify, wherein said base station is owned by an owner of said private network.

In the same field of endeavor, Acampora discloses a base station that is owned by a public or network or service provider, furthermore leasing said base station on a residential property (*col. 15, lines 18-28*).

Therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to have Takahashi et al. base station to being owned by a

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carrier network as taught by Acampora, for the purpose of allowing system operability in remote areas wherein the system coverage does not reach residents of such areas due to geographical isolation to the system.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Cukier et al. (U.S. Pat. No. 6,175,570), Method and Apparatus for Shaping the Output Traffic in a Fixed Length Cell Switching Network Node.

b. Lucidarme et al. (U.S. Pat. No. 6,615,035), Public Mobile Communication System Compatible Wireless Communication System.

c. Sibecas et al. (U.S. Pat. No. 5,940,756), Method for Transmitting Paging Communication on a Cellular Communication System.

d. Buhrmann et al. (U.S. Pat. No. 6,035,193), Telephone System Having Land-Line-Supported Private Base Station Switchable into Cellular Network.

10. Any response to this Office Action should be **faxed to** (703) 872-9306 or **mailed to:**

Commissioner of Patents and Trademarks

P.O. Box 1450

Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

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Crystal Park II

2021 Crystal Drive

Arlington, VA 22202

Sixth Floor (Receptionist)

11. Any inquiry concerning this communication on earlier communications from the Examiner should be directed to Ismael Quiñones whose telephone number is (703) 305-8997. The Examiner can normally be reached on Monday-Friday from 8:00am to 5:00pm.


12. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Marsha D. Banks-Harold can be reached on (703) 305-4379, and fax number is (703) 746-9818. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9301.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose number is (703) 305-4700 or call customer service at (703) 306-0377.

Ismael Quiñones

I.Q.

April 19, 2004


RAFAEL PEREZ-GUTIERREZ
PATENT EXAMINER
4/19/04